

## REMARKS

Claims 21-36 are pending in the instant application. Claims 21-36 have been rejected by the Examiner. The Applicant submits that claims 21-36 are in condition for allowance and requests reconsideration and withdrawal of the outstanding rejections.

### Claim Rejections Under 35 USC § 112

Claims 21-36 have been rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 21 and 29, the Examiner states that the term “time consuming” is relative, thereby rendering the claim indefinite. The Examiner further states that the term “is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention” (Office Action dated February 8, 2006). The Applicants respectfully traverse the rejection and submit that the term “time consuming” as recited in claims 21 and 29 is sufficiently definite. MPEP 2173.05(b) states “[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

MPEP 2173.05(b) further provides “[w]hen a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention.”

The Applicants submit that the term “time consuming” is sufficiently definite at least for the reason that one of ordinary skill in the art would be reasonably apprised of the scope of the invention. Over time, as continued advancements are made in the field of Internet technology, what may be considered to be a “time consuming” search in the field of web searching will certainly vary. For example, web searches performed a few years ago using a “dial up” Internet connection and telephone modem initiated by a web client on a slow speed processor typically

took several minutes. Today, the same search performed via a broadband connection may take seconds. Therefore, the term “time consuming” as it applies to the field of web searches is, *by design*, relative. Given the state of Internet technology at a particular point in time, one of ordinary skill in the art would clearly understand the concept of what might constitute a “time consuming” search and, as a result, would be apprised of the scope of the invention. For at least the reasons presented above, the Applicants submit that claims 21 and 29 are sufficiently definite.

Moreover, the measure or degree of time in determining what constitutes a “time consuming” search is not critical to the features recited in claims 21 and 29. What *is* relevant, however, are *the functions performed* upon a determination that a search is time consuming. Accordingly, the Applicants respectfully submit that the term “time consuming” is sufficiently definite and complies with the provisions of 35 U.S.C. 112, second paragraph. Claims 22-28 and 30-36 depend from claims 21 and 29. At least for reasons of dependency, the Applicants submit that claims 22-28 and 30-36 are sufficiently definite. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

#### **Claim Rejections Under 35 USC § 103**

Claims 21, 22, 24-30 and 32-36 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,892,354 issued to Servan-Schreiber et al. (hereinafter “Servan”) in view of U.S. Patent No. 6,192,414 issued to Horn. The Applicants respectfully traverse the outstanding rejections of claims 21, 22, 24-30, and 32-36 at least for the reasons presented herein.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Neither Servan-Schreiber, nor Horn, either alone or in combination, teach or make obvious the features recited in claims 21 and 29. Claims 21 and 29 respectively recite a method and storage medium for monitoring the presence of a web client from a server. Claims 21 and 29 further recite, *inter alia*,

***“conducting searches for data in response to receiving requests for information from web clients; and***

***if one of the searches becomes time consuming, determining a continued presence of the web client associated with the time-consuming search,*** the determining comprising:

transmitting a byte stream to the web client;

waiting a specified time period;

if an error response is returned from the web client indicating the web client is no longer present, ***aborting the search.***”

Neither Servan-Schreiber, nor Horn teach conducting searches for data in response to receiving requests for information from web clients and determining a continued presence of the web client associated with the time-consuming search, and aborting the search if an error response is returned indicating that the web client is no longer present. There is simply no mention of web searches in either reference. Servan-Schreiber teaches content (i.e., advertisement) is downloaded to a web client and the downloaded content is displayed on the web client device ***when the web client accesses a link at a web site*** (see, for example, column 3, lines 6-15, which states “[T]he user’s web browser includes software [for]...determining whether its communication link is idle and communicating to a remote server...that it’s communication link is idle. During such idle time, the user’s web browser accesses (i.e., links to) a preprogrammed web site (e.g., remote server 26), and upon accessing the remote server, appropriate transmissions are supplied...at which time, the remote server transmits to user 24 the advertising page that is to be displayed...[and] is stored (cached) in the computer’s memory or hard disk”. Column 3 goes on to disclose, “the user clicks on a link from the currently displayed web page in order to ***request that new web page be downloaded and displayed***...the new http connection then is established, and simultaneously, the cached advertising page...is displayed” (column 3, lines 22-30). Thus, the activities described in Servan-Schreiber are performed as a result of a web client accessing a web link at a web site and are not performed as a result of a time-consuming search as recited in claim 1. Further support may be found throughout Servan-

Schreiber, e.g., column 4, lines 1-5, which states “the advertising technique...is implemented by means of a zooming web browser which essentially ‘slips’ each advertising page between two web content pages *as the user hyperlinks from one page to another*” (emphasis added). Horn is directed to a communications network that provides backup or redundancy capability through multiple network connections for ensuring system reliability. Horn is entirely devoid of teaching any type of web search activities. Thus, the features recited in claims 21 and 29, “*conducting searches for data in response to receiving requests for information from web clients*; and

if one of the *searches* becomes time consuming, *determining a continued presence of the web client associated with the time-consuming search*, the determining comprising:

transmitting a byte stream to the web client;

waiting a specified time period;

if an error response is returned from the web client indicating the web client is no longer present, *aborting the search*”, are neither taught by, nor rendered obvious in view of, the cited references, either alone or in combination. For at least these reasons, the Applicants submit that claims 21 and 29 are in condition for allowance. Claims 22 and 24-28 depend from what should be an allowable claim 21. Claims 30 and 32-36 depend from what should be an allowable claim 29. For at least these reasons, the Applicants submit that claims 22, 24-28, 30, and 32-36 are also in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Claims 23 and 31 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Servan-Schreiber and Horn as applied to claims 21 and 29, and further in view of U.S. Patent No. 6,674,713 issued to Berg et al. (hereinafter “Berg”). Claim 23 depends from what should be an allowable claim 21 and claim 31 depends from what should be an allowable claim 29. For at least these reasons, the Applicants submit that claims 23 and 31 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections.

Assuming, *arguendo*, that all elements of Applicants’ claims 21 and 29 are disclosed in the cited references, the Applicants submit that obviousness cannot be properly established by locating references that describe various aspects of a patent applicant=s invention without also providing evidence of the motivating force which would have impelled one skilled in the art to

do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App.Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). The Applicants submit that the Examiner has not made a prima facie case of obviousness because there is no suggestion in the references themselves, or from the knowledge available to one of ordinary skill in the art, to modify or combine these references. Thus, the Applicants submit that claims 21 and 29 are not rendered obvious by the cited art references. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

### CONCLUSION

It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested. It is submitted that the foregoing remarks should render the case in condition for allowance.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 09-0463.

Respectfully Submitted,

FRANK J. DEGILIO ET AL.

CANTOR COLBURN LLP  
Applicants' Attorneys

By Marisa J. Dubuc  
Marisa J. Dubuc  
Registration No. 46,673  
Customer No. 46429

Date: May 8, 2006  
Address: 55 Griffin Road South, Bloomfield, CT 06002  
Telephone: (860) 286-2929  
Fax: (860) 286-0115